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31 JUL 2007

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In re Application of OGILVY
Application No.: 10/585,133
PCT No.: PCT/AU00/00833
Int. Filing: 12 July 2000
Priority Date: 12 July 1999
Attorney Docket No.: CRD-0008
For: IMPROVED APPARATUS FOR REMOTE
PAYMENT TRANSACTIONS

DECISION ON
PETITION
UNDER 37 CFR 1.47(b)

This is a decision on applicant's petition under 37 CFR 1.47(b), filed in the United States Patent and Trademark Office (USPTO) on 18 April 2007, to accept the application without the signature of sole inventor IAN CHARLES OGILVY. Applicant's request for a five month extension of time is granted.

BACKGROUND

On 18 September 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 18 April 2007, applicant filed the instant petition under 37 CFR 1.47(b) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requests the acceptance of the application without the signature of the sole inventor alleging that Mr. Ogilvy is unavailable to sign the application.

DISCUSSION

At the outset, Petitioner is advised to file a change of correspondence address with the USPTO as it appears that to date, such change has not been filed by counsel.

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied Item (1) with payment of the requisite petition fee and Item (3) with a statement of the last known address of the inventor.

With regard to Item (2), Petitioner provided Andrew Smyth's statement of first hand knowledge of the facts regarding the unavailability of the inventor. Mr. Smyth states Mr. Ogilvy is no longer employed by the assignee or its predecessor and that no contact has been maintained with Mr. Ogilvy since 2001. Apparently, when Mr. Ogilvy left CardSoft, he left no forwarding address. Several communications directed to shareholders of CardSoft were sent to Mr. Ogilvy's mother without reply. No further efforts to locate the nonsigning inventor were attempted and detailed in the statement.

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, diligent efforts made to locate the nonsigning inventors were not pursued and documented such as Internet searches, any attempts to obtain Mr. Ogilvy's current address, current email address and/or current employer. No attempt to reach the nonsigning inventor by telephone was made. No request from the Postal Service for their forwarding address was made. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any search for Mr. Ogilvy's new address was made. Since no attempts to locate inventor Ogilvy were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

As for Item (4), petitioner has not provided an declaration, in compliance with 37 CFR 1.497(a) and (b) and executed on behalf of the inventor by the 37 CFR 1.47(b) petitioner. The submitted declaration incorrectly identifies Donald E. Sweet, President of CardSoft, Inc. as "the original, first and sole inventor" and does not identify the 37 CFR 1.47(b) applicant. The declaration is unacceptable and a new declaration, in compliance with 37 CFR 1.497(a) and (b), which identifies the 37 CFR 1.47(b) applicant, is required. Item (4) is not yet satisfied.

Regarding Item (5), Section 409.03(f) of the MPEP, Proof of Proprietary Interest, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)....

When an inventor has agreed in writing to assign an invention described in an

application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner provided an assignment executed by the nonsigning inventor Ogilvy with CardSoft International Pty Limited. However, this assignment does not identify and is not directed to the U.S. application 10/585,133 or the PCT application PCT/AU00/00833 at issue. No assignment for these applications signed by the inventor was attached to the petition to prove this interest. Nor was a written agreement by the inventor to assign presented.

Where there is no written agreement to assign or the invention has not been assigned, petitioner must demonstrate a proprietary interest by an appropriate legal memorandum. No such memorandum accompanied the petition. Item (5) is not satisfied.

As for Item (6), irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party and to prevent irreparable damage." Such statement has been presented. Item (6) is satisfied.

Accordingly, items (2), (4), and (5) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

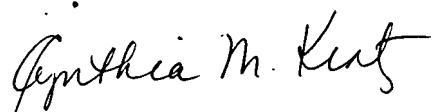
CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the

contents of the letter marked to the attention of the Office of PCT Legal Administration.



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